

II. Remarks

A. Introduction.

Reconsideration and allowance of the subject application are respectfully requested. Upon entry of this Amendment, Claims 1-9, 12-18, and 20-22 will be pending in the instant application. Of the examined claims, Claims 1 and 14 are independent. Claim 19 has been canceled. No new matter has been added.

B. The rejections under 35 U.S.C. §112.

Claims 3 and 19 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Regarding Claim 3, it is well known in the art that an isolated double bond is one that is neither conjugated nor cumulative. (See IUPAC Compendium of Chemical Terminology, 2d Edition, (1997)). Thus, Claim 3 is not indefinite. Claim 19 is canceled, thus rendering moot the objections thereof. Applicant requests that these rejections be withdrawn.

C. The '104 Application was not published and is not available as a reference under any provision of 35 U.S.C. §102.

Independent Claims 1 and 14 and dependent Claims 2-9, 12-13, and 15-22 stand rejected under 35 U.S.C. §102(a) as being anticipated by PCT/BE02/00104 ("the '104 Application"). Applicants traverse this rejection.

The Office Action alleges that the '104 Application was published on June 21, 2002, and has provided Applicants with a one page abstract from the '104 Application. The abstract does not appear as a published international application. In trying to obtain a copy of the published international application for the '104 Application, Applicants have determined that the '104 Application was not published and is the priority document for PCT/BE03/00107 ("the '107 Application"). Applicants have copied and attached the front page of the '107 Application for the Examiner's convenience. Also, Applicants have disclosed the PCT/BE03/00107 in an accompanying Information Disclosure Statement.

First, the '104 Application, cited by the Examiner, is not available as a reference under any provision of 35 U.S.C. §102. The one-page abstract provided to Applicants is a copy from the priority document for the '107 Application and not a publication. Because, the '104 Application is not published, the '104 Application cannot qualify as a reference under Section 102(a), Section 102(b) or Section 102(e). Thus, the rejections based on the '104 Application are improper and must be withdrawn.

Second, '107 Application, the international application that claims the priority of '104 Application, is not available as a reference under any provision of 35 U.S.C. §102. The present

application is a national stage application of PCT/EP03/06265, filed on June 13, 2003, and claims a priority of June 21, 2002. The '107 Application has an effective US filing date of June 17, 2003 and was published on December 31, 2003. Thus, the earliest effective US filing date and publication of the '107 Application is after the present application. Thus, the '104 Application cannot qualify as a reference under Section 102(a), Section 102(b) or Section 102(e).

D. Simone fails to arrive at the specific R groups and X groups as claimed.

Independent Claims 1 and 14 and dependent Claims 2-9, 12-13, and 15-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,332,927 to Simone ("Simone"). Applicant traverses this rejection.

Claim 1 recites a polyurethane article with low fogging characteristics derived from a polyurethane forming reaction mixture containing as a catalyst for the mixture an organotin compound having low emissivity of the general formula:



wherein R is methyl and X is a carboxylate group with 14-20 carbon atoms having at least one olefinic double bond. The specific combination of methyl groups and carboxylate groups provides an organotin compound with low emissivity. The use of such a low emissivity catalyst yields polyurethane articles with significantly reduced fogging characteristics. (Present application, TABLES 6 and 7). Independent Claim 14 recites features similar to Claim 1.

The Office Action concedes that Simone differs from the present claims in that Simone does not teach or suggest the claimed R groups and X groups. The Office Action attempts to remedy this deficiency by stating that "it would have been obvious . . . to have operated within the selections of catalysts provided for by Simone for the purposes of imparting their known reaction catalyzing effect in order to arrive at applicants' claims." (See Office Action, page 4).

Applicant submits herewith a Declaration, under 37 C.F.R. §1.132, signed by the inventor, Dr. Oliver Schumacher. In the Declaration, Dr. Schumacher states that, in the claimed organotin catalyst, he would expect that R groups having fewer carbon atoms would produce an organotin compound (and a resultant polyurethane compound) having a greater emissivity (greater fogging) into air or water. Thus, it is surprising and unexpected that methyl R groups, as claimed, produced an organotin catalyst having low emissivity.

There is nothing in Simone that teaches or suggests that methyl R groups would produce a low emissivity organotin catalyst. To the contrary, Simone, which does not even address the problem of emissivity, states that its preferred catalysts are *dioctyltin* diricinoleate, *dioctyltin* dioleate, *didodecyltin* diricinoleate and *dioctyltin* di-6-hydroxy caproate, each of which include

significantly larger R groups--C₈ and C₁₂. Thus, Simone actually teaches away from the use of the claimed methyl groups.

Dr. Schumacher further states that the teachings of Simone are not directed to the problem of fogging or emissivity of polyurethane compounds and that Simone does not provide a solution to the problem of fogging or emissivity of polyurethane compounds. Thus, there is absolutely nothing in Simone that would motivate one of ordinary skill in the art to utilize dimethyltin catalysts to solve the problem of reducing emissivity of polyurethane compounds.

It is well settled law that, in a single reference obviousness rejection, it is necessary that the single reference arrive at the claimed invention. (*In Re Mills* 916 F.2d 680 (Fed.Cir. 1990)). Simone merely provides hundreds of possible combinations for R and X groups. Nowhere does Simone teach or suggest that methyl R groups would produce organotin catalysts with low emissivity characteristics--in fact, Simone does not even address the problem of emissivity. Further, those of ordinary skill in the art would expect the exact opposite--that methyl R groups would produce organotin catalysts with high emissivity characteristics. Still further, as indicated above, Simone actually teaches away from the invention of Claims 1 and 14 and suggests that its preferred candidates for R groups are groups of C₈ and higher. Simone's teaching and suggestion is a far cry from "arriving at the claimed invention," as is required. Accordingly, the Office Action's overly broad assertion that it would have been obvious to derive the very specific dimethyltin catalysts, as claimed, is improper. The rejection should be withdrawn.

E. Dependent Claims

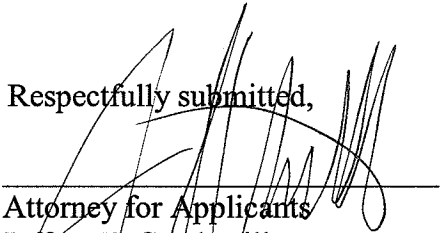
Each of the dependent claims depends from the respective independent claims and, as such, includes all of the features thereof. For the same reasons Claims 1 and 14 are patentable over the cited references, the dependent claims are patentable as well. Applicant requests that these rejections be withdrawn.

F. Conclusion.

In view of the above, it is believed that this application is in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3620. All correspondence should continue to be directed to the address given below.

Respectfully submitted,



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